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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/068,626	02/05/2002	Eric V. Wade	19932/3	8230

7590

10/08/2003

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EXAMINER

LEWIS, RALPH A

ART UNIT

PAPER NUMBER

3732

DATE MAILED: 10/08/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/068,626

Applicant(s)

WADE, ERIC V.

Examiner

Ralph A. Lewis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Claims Renumbered

The originally filed claims skip from claim 15 (page 18) to claim 18 (page 19), leaving out claims 16 and 17. Claims are required to be consecutively numbered, accordingly, originally numbered claims 18-26 have been renumbered 16-34.

Objection to the Specification

The specification is objected to under 37 CFR 1.71 for failing to provide a full, clear concise and exact description of the invention. More particularly, the examiner is confused by applicant's references to the element illustrates in Figure 6A as an "s-shaped valve." A valve is commonly understood to be a device for varying or turning off/on a flow of fluid through a passage. The device of Figure 6A appears to simply be a passage as it appears to lack any type of a mechanism for controlling or varying the flow of the fluid there through. It is confusing and improper to give elements names that do not comply with their commonly accepted definition(s).

Rejections based on 35 U.S.C. 112, second paragraph

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-15, 17, and 28-31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 1, 8, 17, 28 and 29, applicant's use of the terminology "S-shaped valve" is not understood. The disclosed S-shaped structure referred to in the specification does not appear capable of turning on/off or adjusting the flow of fluid through a passage as is required by the conventional definition of a "valve."

In claims 2 and 3, it is unclear how limitations directed to fluids with which applicant intends to use the device with provide for any objectively ascertainable structural limitations.

In claim 5, it is unclear how the "second cover" relates to the claimed "S-shaped valve" and providing fluid to an operating field.

In claim 12, it is unclear as to whether the "bur" is positively claimed as part of the invention. Parent claim 8, indicates that bur is part of the dental handpiece with which the "dental prophylactic system" is intended to be used, but that it is not being claimed as part of the invention. The dependent claim, however, is directed solely to the burs structure even though it is not part of the claimed "prophylactic system." See *In re Rohrbacher*, 128 USPQ 117(1960, CCPA) for guidance in claim drafting.

Rejections based on Obvious-type Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double

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patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1- 31 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-31 of U.S. Patent No. 6,350,124. The patented claims of 6,350,124 include all the limitations of the present claims, the slight variations in the manner in which the present pending claims differ from the patented claims of 6,350,124 would have been obvious to the ordinarily skilled artisan.

Rejections based on Prior Art

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 16, 20, 21, 22 and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Geller (4,693,871).

Geller discloses a dental handpiece 16, the housing of which meets the "inner cover" limitation and an outer cover 50. Applicant should make it clear that the "inner cover" limitation does not include within its scope the housing of the handpiece.

Claims 32 and 34 are rejected under 35 U.S.C. 102(b) as being anticipated by Byer (US 5,310,341).

Byer discloses a dental bur assembly comprised of a dental bur 16 and a splash guard 24 coupled to the bur shaft for propelling liquids and debris away from the handpiece. The Byer splash guard has a variety of different fin arrangements.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 35 is rejected under 35 U.S.C. 103(a) as being unpatentable over Byer (US 5,310,341) in view of Sutter et al (US 5,078,605).

Byer discloses that the splash guard could be locked on to the bur shank mechanically (column 4, lines 31-33), but fails to explicitly state how such mechanical locking would occur and does not disclose the claimed notch mechanical locking. Sutter et al, however, for a dental bur teaches that objects may be snapped into place on a dental bur by providing for a notch in the bur which snaps into place with the object being attached (note Figure 5). To have provided a prior art snap in place notch locking arrangement between the Byer bur and splash guard as the undisclosed mechanical

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locking arrangement suggested by Byer would have been obvious to one of ordinary skill in the art in view of the teaching by Sutter et al.

Prior Art

Saffir (3,324,552) is made of record.

Any inquiry concerning this communication should be directed to **Ralph Lewis** at telephone number **(703) 308-0770**. Fax (703) 872-9302. The examiner works a compressed work schedule and is unavailable every other Friday. The examiner's supervisor, Kevin Shaver, can be reached at (703) 308-2582.

R.Lewis
September 29, 2003



Ralph A. Lewis
Primary Examiner
Au3732